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MAILED
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OFFICE OF PETITIONS

In re Application of
Keresman et al.
Application No. 09/488,297
Filed: January 20, 2000
Attorney Docket No. PRAZ 200001US01
For: SECURE AND EFFICIENT PAYMENT
PROCESSING SYSTEM

DECISION ON PETITION

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Petition under 37 CFR 1.181 to Correct Patent Term Extension," received on July 9, 2010. The petition is being treated under 37 CFR 1.181 and 37 CFR 1.701, as a petition for patent term extension.

The petition is dismissed.

Petitioner asserts that the Notice of Allowance mailed by the Office on March 15, 2010 is incorrect, as it states that the application is only eligible for 682 days of patent term extension. Petitioner asserts that the application is eligible for patent term extension based on a first Notice of Appeal filed on July 14, 2005 to the date of the Decision in favor of applicants, January 21, 2010. Petitioner asserts that the patent term extension was improperly calculated from March 11, 2008, the date of the second notice of appeal to January 21, 2010, the date of the decision in favor of applicants.

Petitioner argues that the Examiner reopened prosecution in an Office Action mailed on December 14, 2006 in response to his Appeal Brief and that the Applicants were not given an opportunity to take the case to the BPAI based on the original appeal brief. Petitioner states that he filed a response to the Office Action with no claim amendments. Petitioner asserts that in response to a Final Office Action mailed on September 7, 2007, a second Notice of Appeal was filed on March 11, 2008. Petitioner argues that no further amendments were submitted after the

original Notice of Appeal, which was filed on July 14, 2005. Petitioner argues that the patent term extension should be calculated from July 14, 2005 to January 21, 2010.

On January 20, 2000, the above identified application was received by the Office.

On July 14, 2005, a Notice of Appeal was received by the Office.

On December 14, 2006, prosecution was reopened by the Examiner.

On June 20, 2007, Applicant elected to file a reply under 37 CFR 1.111.

On September 7, 2007, a Final Rejection was mailed by the Office.

On March 11, 2008, a Notice of Appeal was received by the Office.

On January 21, 2010, a Decision by the BPAI affirming in part the decision of the Examiner was mailed by the Office.

On April 27, 2010, a Notice of Allowance and Issue Fee(s) Due notice, which included a determination that the patent term extension was 682 days, was mailed by the Office.

Applicable Statutes and Regulation

35 U.S.C. 154. Contents and term of patent (in effect on June 8, 1995)

(b) TERM EXTENSION.-

(1) INTERFERENCE DELAY OR SECRECY ORDERS.-If the issue of an original patent is delayed due to a proceeding under section 135(a) of this title, or because the application for patent is placed under an order pursuant to section 181 of this title, the term of the patent shall be extended for the period of delay, but in no case more than 5 years.

(2) EXTENSION FOR APPELLATE REVIEW.-If the issue of a patent is delayed due to appellate review by the Board of Patent Appeals and Interferences or by a Federal court and the patent is issued pursuant to a decision in the review reversing an adverse determination of patentability, the term of the patent shall be extended for a period of time but in no case more than 5 years. A patent shall not be eligible for extension under this paragraph if it is subject to a terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review.

37 CFR 1.701 Extension of patent term due to examination delay under the Uruguay Round Agreements Act (original applications, other than designs, filed on or after June 8, 1995, and before May 29, 2000).

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference proceedings under 35 U.S.C. 135(a); and/or

(2) The application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) Appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision in the review reversing an adverse determination of patentability and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review. If an application is remanded by a panel of the Board of Patent Appeals and Interferences and the remand is the last action by a panel of the Board of Patent Appeals and Interferences prior to the mailing of a notice of allowance under 35 U.S.C. 151 in the application, the remand shall be considered a decision in the review reversing an adverse determination of patentability as that phrase is used in 35 U.S.C. 154(b)(2) as amended by section 532(a) of the Uruguay Round Agreements Act, Public Law 103-465, 108 Stat. 4809, 4983-85 (1994), and a final decision in favor of the applicant under paragraph (c)(3) of this section. A remand by a panel of the Board of Patent Appeals and Interferences shall not be considered a decision in the review reversing an adverse determination of patentability as provided in this paragraph if there is filed a request for continued examination under 35 U.S.C. 132(b) that was not first preceded by the mailing, after such remand, of at least one of an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151.

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of five years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 41.39 of this title in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

(d) The period of delay set forth in paragraph (c)(3) shall be reduced by:

(1) Any time during the period of appellate review that occurred before three years from the filing of the first national application for patent presented for examination; and

(2) Any time during the period of appellate review, as determined by the Director, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Director may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.

(e) The provisions of this section apply only to original patents, except for design patents, issued on applications filed on or after June 8, 1995, and before May 29, 2000.

Opinion

The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154. 35 U.S.C. § 154 provides for patent term extension for appellate review, interference and secrecy order delays in utility and plant applications filed on or after June 8, 1995, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for other specifically defined administrative delays in utility and plant applications filed on or after May 29, 2000.

The above-identified application was filed on January 20, 2000. Accordingly it is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000. Pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995, an applicant can receive patent term extension only if there was an appellate review, interference or a secrecy order delays as set forth in the statute.

The Notice of Allowance and Issue Fee(s) Due Notice included a determination that the patent term extension was 682 days for the period from March 11, 2008, the date that the second Notice of Appeal was filed and ending January 21, 2010, the date of the decision by the BPAI, which is a final decision in favor of the applicant. Petitioner's argument that he is entitled to additional patent term extension for the period from July 14, 2005, the date of receipt of the first Notice of Appeal to March 11, 2008, the date of receipt of the second Notice of Appeal is not persuasive.

A Notice of Appeal was filed in the above-identified application on July 14, 2005. In response to Applicant's Appeal Brief, on December 14, 2006, the Examiner reopened prosecution and set forth a new grounds of rejection and gave Applicant the option of either:

- (1) File a reply under 37 CFR 1.111 (if this office action is non-final) or a reply under 37 CFR 1.113 (if this office action is final); or,
- (2) Initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fees and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in the 37 CFR 41.20 have been increased since they were previously paid, then the appellant must pay the difference between the increased fees and the amount previously paid.

Petitioner's argument that he was not given the option of simply taking the case to the BPAI on the original appeal brief and thus he is entitled to patent term extension for the period from the first filed notice of appeal to the date of the decision by the BPAI is not persuasive. Petitioner was given the option of filing a reply under 37 CFR 1.111 or proceeding to the BPAI by initiating a new appeal followed by an appeal brief. Petitioner did not elect to proceed to the BPAI by filing a new notice of appeal followed by an appeal brief, but elected to file a response pursuant to 37 CFR 1.111. While petitioner now asserts that he did not file any amendments in the further prosecution of the application, he could have filed amendments and he elected to further prosecute the application. Since Petitioner elected to continue prosecuting the application in response to the Examiner's new ground of rejection instead of proceeding to the BPAI, his argument that he is now entitled to patent term extension based on the date of the first notice of appeal to the date of the decision by the BPAI is not persuasive.

The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Petitioner's deposit account has not been charged a petition fee.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.



Mark Polutta

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Office of Patent Legal Administration

Office of the Deputy Commissioner

for Patent Examination Policy